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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,268	01/29/2002	Warren Keith Edwards	PARC-DA1085	2691
35699 7590 12/19/2007 PVF -- PARC c/o PARK, VAUGHAN & FLEMING LLP 2820 FIFTH STREET DAVIS, CA 95618-7759			EXAMINER CHANKONG, DOHM	
			ART UNIT 2152	PAPER NUMBER
			MAIL DATE 12/19/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/058,268	<b>Applicant(s)</b> EDWARDS ET AL.	
	<b>Examiner</b> Dohm Chankong	<b>Art Unit</b> 2152	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3-12,14-23 and 25-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-12,14-23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

1> This action is in response to Applicant's request for continued examination, filed 9.26.2007. Claims 1, 8, 12, 19, 23, and 30 are amended. Claims 1, 3-12, 14-23, and 25-33 are presented for further examination.

2> This is a non-final rejection.

### *Response to Arguments*

#### I. APPLICANT'S AMENDMENTS DO NOT OVERCOME THE REED REFERENCE.

Applicant's amendments, which suffers from §112 issues, do not overcome the Reed reference. Additionally, Applicant's arguments that Reed teaches away from the limitation have been considered but are not persuasive for the reasons below.

##### A. Applicant's amendment suffers from §112, second paragraph issues.

Applicant amends the independent claims to recite that "components do not have a priori knowledge of each other's domain specific interfaces and protocols." This language renders the claim indefinite. In using the "a priori" language, the limitation fails to establish a time frame for when the components are to have knowledge of the interfaces and protocols (that is, "a priori" relative to what event?). The components must eventually have some knowledge of each other's domain specific interfaces and protocols in order to effect proper communications to one another. Put another way, there needs to be language in the claim that recites when the components do not have knowledge and they do obtain that knowledge rather than rely on the "a priori" language which is a relative term.

- B. Applicant's amendment does not affect the claim scope for system claims 1, 8, 23, and 30.

Language that does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. MPEP §2111.04. Examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim include "wherein" clauses. Id.

Here, Applicant's amendment relies on a "wherein" clause. Additionally, the amendment as written does not affect the actual structure of the claim. Applicant should amend the limitations to recite the structural elements that enable the components to communicate with one another despite not having a priori knowledge of the interfaces and protocols.

- C. Reed teaches that the components do not have a prior knowledge of each other's interfaces and protocols.

Reed teaches that the provider and consumer do not have a priori knowledge of each other's interfaces until the provider sends a communication object to the consumer. The consumer can then negotiate with the provider and select a desired protocol or format for which to continue the communications [column 12 «lines 47-50»]. In other words, the provider sends a communication object with information about the protocols and formats that the provider can support but without knowledge of which protocols and formats the consumer can support [column 54 «lines 28-49»].

Reed also discloses that the consumer computer can send native interfaces to the provider that allow the provider to send appropriately formatted data to the consumer

[column 16 «lines 20-23»]. This teaching clearly implies that the provider does not have a priori knowledge of the consumer's interfaces.

D. Reed does not teach away from the claimed limitation.

A "prior art's mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed." MPEP §2143(I) (citing In re Fulton, 391 F.3d 1195, 1200-01 (Fed. Cir. 2004)). Thus, a prior art reference "teaches away" from a particular solution when it criticizes, discredits or discourages the solution claimed.

First, Reed does not expressly criticize or discourage the possibility that components must not have a priori knowledge. Second, Reed discloses the limitation as discussed above. As to Applicant's arguments, Applicant cites various portions of the Reed reference which Applicant asserts prove that Reed's components require prior knowledge of protocols between the provider and consumer. However, none of the cited portions support the assertion.

Applicant cites lines 39-43 of column 8. The section recites that information that is passed between the provider and consumer is formatted according to known protocols such as HTTP, MIME or HTML. But this section does not disclose that the provider and consumer must know of the protocols prior to the transfer. The section stands for the unremarkable position that data can be stored according to different, but well known protocols.

Next, Applicant cites lines 39-43 of column 14. This section recites that "*the provider* knows what communication networks, network addresses, languages...and other

communications processing data and methods are supported *by the provider*" (emphasis added). This section stands for the unremarkable position that a provider computer must be aware of the networks and protocols that the provider can support.

Applicant then cites lines 6-11 of column 15. This section recites one possible embodiment of the invention where the provider and consumer use standard Internet protocols to communicate. However, this teaching simply stands for the position that provider and consumer use standard protocols to communicate. The teaching does not talk about whether the provider and consumer must have prior knowledge of which standard protocols are to be used during the communication session.

Applicant next signs lines 16-18 of column 15 and notes that "a server must a priori know the interfaces and protocols of the browser in order for the browser to display, process, and store the information transferred from the server." However, Applicant's assertion ignores the following sentence which states that any protocol can be used which is "in accordance with the selected protocol or format." One of ordinary skill in the art would have clearly interpreted this section as teaching that the provider and consumer had negotiated (and then selected) the appropriate protocol for communication. The negotiation implies that the provider and consumer did not have a priori knowledge.

Finally, Applicant cites lines 16-22 of column 15. This section recites that protocols or other formats can be used in with the interface program. Again, this section does not disclose or imply that the components must have a prior knowledge of each other's interfaces and protocols. As stressed throughout these remarks and highlighted in section C above, the provider and consumer negotiate the communications interfaces for the session without a

priori knowledge. This is implied from the fact that the consumer selects the protocol before establishing the communications session between the provider and the consumer.

## II. CONCLUSION

Based on the foregoing remarks, Applicant's arguments are not considered persuasive. Applicant's amendment does not overcome the Reed reference.

### *Continued Examination Under 37 CFR 1.114*

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9.26.2007 has been entered.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4> Claims 1, 3-12, 14-23, and 25-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Claims 1, 8, 12, 19, 23, and 30 are rejected for containing language that renders the claims indefinite. The claims recite that components do not have "a priori"

knowledge of each other's interfaces and protocols. However, this language is unclear because the claims fail to recite a time frame for when the components do or do not have knowledge of the interfaces and protocols (that is, it is unclear a priori to relative to when?).

b. The remaining claims are rejected based on their dependency on the parent claims.

*Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5> Only those claims that have been amended are formally addressed in this action.

Those claims not formally addressed in this action remain rejected for the same reasons set forth in the previous Office action. Thus, the body of the rejection of those claims can be found in the previous action.

6> Claims 1, 3-12, 14-23, and 25-33 are rejected under 35 U.S.C § 103(a) as being unpatentable over Reed et al, U.S Patent No. 6,345,288 ["Reed"], in view of Bischoff et al, U.S Patent No. 6,718,377 ["Bischoff"].



7> As to claim 1, Reed discloses a system for enabling components to transfer data between each other, the system comprising:

a plurality of components including a first component having a data object that implements a universal data transfer interface [Figure 1 | column 7 «line 59» to column 8 «line 3» | column 105 «line 66» to column 106 «line 16» where : Reed's distribution service object is analogous to Applicant's data object];

a second component capable of receiving the data object [Figure 1 «item 32» | Figure 28 «item 1302»] and invoking the universal data transfer interface to cause a data transfer session object (DTSO) to be sent to the second component [column 98 «lines 14-24» where :the communications object is sent using the methods (interface) of the distribution service object], wherein the second component acts as an intermediary component, which facilitates transferring of the DTSO from the first component to a third component [Figure 1 | Figure 28 | column 12 «line 63» to column 13 «line 3» | column 14 «lines 43-53» | column 86 «lines 64-66» : transferring of the message object with the communications object and Reed's web server corresponds to the second component. The distribution server facilitates transferring of the DTSO from the first component (provider computer) to the third component (consumer computer)];

wherein the DTSO is capable of being invoked by the third component to transfer data between the first component and the third components [column 8 «lines 6-19» | column 17 «lines 25-28» | column 67 «lines 17-65» | column 70 «lines 51-67» where : Reed's communications object is analogous to Applicant's claimed DTSO ];

wherein the DTSO includes instructions that enable the first component to receive asynchronous event notifications [column 14 «lines 24-56» : “notification of the provider” | column 56 «lines 15-52»];

wherein the DTSO includes instructions to return device type and operating status of the first component [column 49 «lines 21-50»];

wherein the DTSO includes instructions to enable the first component or the third component to negotiate with each other to select a transfer medium to use to transfer data based upon the type of data [column 12 «lines 44-50» | column 53 «line 54» to column 54 «line 49»]; and

wherein the components do not have a priori knowledge of each other's domain specific interfaces and protocols [column 54 «lines 28-49»];

Reed does disclose that the second component (provider computer) is aware of the data type supported by the first component (consumer) [column 14 «lines 21-59»] and also the first component can provide means, such as special forms, for the second component to return specific types of data [column 14 «lines 26-32»].

Reed however does not expressly disclose instructions to return data types supported by the first component. In the same field of invention, Bischoff is directed towards a system with a provider and consumer computer (analogous to claimed second and first component, respectively) [abstract]. Like Reed, the provider and consumer are enabled to communicate with one another using a standardized interface comprised of various communication objects located at the computers [column 2 «lines 14-30 and 65-67»]. To achieve this functionality, Bischoff discloses returning data types from the consumer computer that are supported by

the consumer computer to the provider computer to enable communications between the consumer and provider computer [Figure 4 | column 2 «lines 20-30» | column 7 «lines 56-67»].

It would have been obvious to one of ordinary skill in the art to modify Reed with Bischoff's teachings. One would have been motivated to provide such a combination to provide a means for Reed to obtain the supported data formats and types of a consumer computer as represented by Bischoff's feature.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Application/Control Number:  
10/058,268  
Art Unit: 2152

Page 11

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A handwritten signature in black ink, consisting of a stylized 'D' followed by a cursive 'C' and a long horizontal stroke.

DC  
12/17/07